REMARKS

Forty-two claims were originally filed in the present Application, and claims 43-47 were subsequently added by amendment. Claims 1-19, 21-39, and 41-42 have been cancelled, and claims 20, 40, and 43-47 currently stand rejected. Claims 20, 40, 43-47 are amended herein. In addition, new claims 48-54 are added herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

Patent Drawings

In the Office Action Summary attached to the present Office Action mailed on May 27, 2003, the Examiner indicates that "[t]he drawing(s) filed on 08 June 1998 is/are objected to by the Examiner." However, Applicant finds no specific mention in the case file regarding any objections to the originally-filed drawings. Applicants therefore respectfully request the Examiner to provide such an indication regarding the patent drawings in the present Application, so that Applicant may respond in an appropriate manner. In the alternative, Applicant requests the Examiner to explicitly indicate that no corrections to the drawings are necessary, and to formal withdraw the objection.

35 U.S.C. § 103

In paragraph 3 of the Office Action, the Examiner rejects claims 43-46 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,367,080 to Enomoto et al. (hereafter Enomoto) in view of U.S. Patent No. 5,745,910 to Piersol et al. (hereafter Piersol). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

> "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicant respectfully traverses the Examiner's assertion that modification of the device of Enomoto according to the teachings of Piersol would produce the claimed invention. Applicant submits that Enomoto in combination with Piersol fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicant also submits that neither Enomoto nor Piersol contain teachings for combining the cited references to produce the Applicant's

claimed invention. The Applicant therefore respectfully submits that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of independent claim 43, Applicant responds to the Examiner's §103 rejection as if applied to amended independent claim 43 which is now amended to recite *"said video window being selectively positionable and sizeable within said Internet page data,"* which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto.

Enomoto essentially teaches horizontally compressing video information and Internet information for *side-by-side display* on a television in a *split-screen* arrangement" (see FIG. 16B). Neither the video information nor the Internet information is compressed in a vertical direction. The teachings of Enomoto are therefore limited to "displaying both the television program and the Internet screen half and half . . ." (column 4, lines 29-32) "to display the screen by dividing into two parts of left and right . . ." (column 4, lines 16-17).

Applicant submits that Enomoto nowhere teaches or suggests a "video window being selectively positionable and sizeable *within* said Internet page data" as claimed the Applicant. Enomoto is limited to displaying video information on a fixed one-half of a television screen that is not "within" the Internet page data, as claimed by Applicant. Applicant therefore submits that Enomoto *teaches away* from Applicant's invention. A prior art reference which teaches away from the presently claimed invention is "strong evidence of nonobviousness." In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed.Cir. 1987).

The Examiner concedes that Enomoto fails to disclose "the page data being scrollable with reference to the video window . . . ." Applicant concurs. The Examiner then points to Piersol to purportedly remedy this deficiency. Piersol essentially teaches using "parts" to create compound documents by dragging and dropping the desired "parts" into the compound document (see FIGS. 2A and 2B). However, Piersol nowhere mentions or discloses displaying either video data or Internet data. In contrast, Applicant teaches and claims selectively positioning a "video window" within "Internet page data". Applicant therefore submits that Piersol is non-analogous art.

With regard to claim 44, the Examiner states "[i]t is obvious . . . that the format manager positions a video tag to vertically location the video window . . . ." Applicant respectfully submits that neither of the cited references teach or disclose positioning "a video tag to vertically locate said video window on said display device in relation to a current reference position on said display device," as claimed by Applicant.

With regard to claim 45, the Examiner states "Piersol teaches the format manager copies the page data to create duplicate page data . . . ." Applicant respectfully submits that neither of the cited references teach or disclose copying "Internet page data" to create "duplicate Internet page data," as claimed by Applicant in claim 45.

With regard to claim 46, the Examiner states "Piersol teach the page data can be scroll (sic) . . . ." Applicant disagrees with this interpretation of Piersol, and submits that Piersol fails to teach scrolling page data of the background

document, but rather teaches scrolling of information within the embeddable "frames" (see column 6, lines 24-39).

Further regarding the Examiner's rejection of dependent claims 44-46, for at least the reasons that these claims are directly or indirectly dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 44-46 so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicant submits that claims are not unpatentable under 35 U.S.C. § 103 over Enomoto in view of Piersol, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 43-46 under 35 U.S.C. § 103.

In paragraph 4 of the Office Action, the Examiner rejects claims 20, 40, and 47 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,367,080 to Enomoto et al. (hereafter Enomoto) in view of U.S. Patent No. 5,745,910 to Piersol et al. (hereafter Piersol), and further in view of U.S. Patent No. 6,222,541 to Bates et al. (hereafter Bates),. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for

a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of independent claims 20 and 40, Applicant responds to the Examiner's §103 rejection as if applied to amended independent claims 20 and 40 which are now amended to recite *"said format manager copying said page data to create duplicate page data, inserting a video tag into said duplicate page data, and selectively positioning said video tag to vertically locate a video window on a display device in relation to a current reference position on said display device, said video window being repositionable and resizeable within said duplicate page data on said display device,"* which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto.

As discussed above, Enomoto essentially teaches horizontally compressing video information and Internet information for *side-by-side display* on a television in a *split-screen* arrangement" (see FIG. 16B). Neither the video information nor the Internet information is compressed in a vertical direction. The teachings of Enomoto are therefore limited to "displaying both the television program and the Internet screen half and half . . ." (column 4, lines 29-32) "to display the screen by dividing into two parts of left and right . . ." (column 4, lines 16-17).

Applicant submits that Enomoto nowhere teaches or suggests a "*video window being repositionable and resizeable within said duplicate page data on said display device*" as claimed the Applicant. Enomoto is limited to displaying

video information on a fixed one-half of a television screen that is not "within" the Internet page data, as claimed by Applicant. As discussed above, Applicant therefore submits that Enomoto *teaches away* from Applicant's invention. A prior art reference which teaches away from the presently claimed invention is "strong evidence of nonobviousness." In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed.Cir. 1987).

The Examiner concedes that Enomoto fails to disclose "the format manager copying the page data to create duplicate page data, inserting a video tag into the duplicate page data, and selectively positioning the video tag to vertically locate a video window one a display device, the duplicate page data being scrollable with reference to the video window on the display device, the format manager computing a current reference to the video window on the display device . . . ." Applicant concurs. The Examiner then points to Piersol to purportedly remedy these deficiencies.

Piersol essentially teaches using "parts" to create compound documents by dragging and dropping the desired "parts" into the compound document (see FIGS. 2A and 2B). However, Piersol nowhere mentions or discloses displaying either video data or Internet data. In contrast, Applicant specifically teaches and claims selectively positioning a "video window" within "Internet page data". Applicant therefore submits that Piersol is non-analogous art.

The Examiner further states that "neither Enomoto nor Piersol specifically disclose the current reference position being computed by combining a prior reference position and a scroll value. Applicant agrees. The Examiner then

points to Bates to purportedly remedy this deficiency. Applicant respectfully disagrees with this interpretation of Bates.

Bates essentially teaches a "sinkhole mechanism" for slowing a scrolling rate when multiple Internet links are displayed within the range of a scrolling slider" (see column 9, lines 13-55). The Examiner states that "Bates teaches the current reference position is computed by combining a prior reference position and a scroll value," as claimed by Applicant.

Applicant submits that Bates teaches calculating a position of the scrolling slider, and not of any type of current reference position as claimed by Applicant. In addition, Bates teaches that the current position of the scrolling slider is calculated "based upon, the previous position of the slider, the current position of the slider, and the number of links within the slider range" (see column 9, lines 29-38). Applicant therefore submits that Bates does not teach a "current reference position" that is computed by "combining a prior reference position and a scroll value," as claimed by Applicant.

Regarding the Examiner's rejection of dependent claim 47, for at least the reasons that this claim is indirectly dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of dependent claim 47, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claim 47 so that this claim may issue in a timely manner.

For at least the foregoing reasons, the Applicant submits that claims are not unpatentable under 35 U.S.C. § 103 over Enomoto in view of Piersol and

Bates, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 20, 40, and 47 under 35 U.S.C. § 103.

New Claims

The Applicant herein submits additional claims 43-54 for consideration by the Examiner in the present Application. The new claims 48-54 recite specific details for implementation and utilization of Applicant's invention, as disclosed and discussed in the Specification. Applicant submits that newly-added claims 48-54 contain a number of limitations that are not taught or suggested in the cited references. Applicant therefore respectfully requests the Examiner to consider and allow new claims 48-54, so that these claims may issue in a timely manner.

Summary

Applicant submits that the foregoing amendments and remarks overcome the Examiner's rejections of claims 20, 40, and 43-47. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicant therefore submits that the claimed invention is patentable over the cited art, and respectfully requests the Examiner to allow claims 20, 40, and 43-54 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicant's undersigned representative at the number provided below.

Respectfully submitted,

Date: 8/18/03

By: _____

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